



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,191	03/24/2004	Maria Theresa Barnes-Leon	384818042US1	6005
25096	7590	01/04/2005		
PERKINS COIE LLP PATENT-SEA P.O. BOX 1247 SEATTLE, WA 98111-1247			EXAMINER WONG, LESLIE	
			ART UNIT 2167	PAPER NUMBER

DATE MAILED: 01/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/809,191

Applicant(s)

BARNES-LEON ET AL.

Examiner

Leslie Wong

Art Unit

2167

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on 24 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Specification

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 13-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The language of the claim raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C 101.

To expedite a complete examination of the instant application the claims rejected under 35 U.S.C. 101 (nonstatutory) above are further rejected as set forth below in anticipation of applicant amending these claims to place them within the four categories of invention.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1 and 12 are **provisionally** rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 and 24 of copending **Application No. 10/809,943**.

Claims 1 and 24 of patent application # 10/809,943 contains every element of claims 1 and 12 of the instant application and as such anticipates claims 1 and 12 of the instant application.

"A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). " **ELI LILLY AND COMPANY v BARR LABORATORIES, INC.**, United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30,

Art Unit: 2167

2001).

This is a provisional obviousness-type double patenting rejection.

5. Claims 1 and 12 are **provisionally** rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 and 9 of copending **Application No. 10/696,371**.

Claims 1 and 9 of patent application # 10/696,371 contains every element of claims 1 and 12 of the instant application and as such anticipates claims 1 and 12 of the instant application.

"A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). " **ELI LILLY AND COMPANY v BARR LABORATORIES, INC.**, United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

This is a provisional obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-12 are rejected under 35 U.S.C. 102(e) as being anticipated by **Hellman et al.** ("Hellman") (US 20030163597A1).

Regarding claims 1 and 12, **Hellman** teaches a method and computer-readable medium in a computing system for managing enterprise data, the method comprising:

- a). extracting enterprise information in a first form that is associated with a first source computerized system (§§ 0045, 0070, 0074);
- b). converting the enterprise information in the first form into corresponding information that is in a second intermediate form (§§ 0058, 0059, 0074, 0198); and
- c). converting the enterprise information in the second intermediate form into a target form that corresponds to a target computerized system, wherein the second intermediate form includes a plurality of custom data type elements that are adapted for capturing customer information and that can be referenced by other data structures in the second intermediate form (§§ 0048, 0071, 0074, 0198, 0202, 0390-0393).

Regarding claim 2, **Hellman** further teaches the steps of:

- a). extracting enterprise information in a third form that is associated with a second source computerized system that is distinct from the first source computerized system (§s 0045 and 0074);
- b). converting the enterprise information in the third form into enterprise information that is in the second intermediate form (§s 0198, 0200); and
- c). converting the enterprise information in the second intermediate form into the target form (§s 0048, 0074).

Regarding claim 3, **Hellman** further teaches wherein the customer information includes information that defines specific aspects of the customer's business (§ 0390).

Regarding claim 4, **Hellman** further teaches wherein the custom data type elements include one or more elements comprising: an address custom data type element; an auto deal custom data type element; an auto policy custom data type element; an auto sales history custom data type element; an auto service history custom data type element; an auto service job custom data type element; an auto service repair order custom data type element; a balance statement custom data type element; a billing profile custom data type element; a bill of material component custom data type element; a bill of material custom data type element; a business unit custom data type element (§s 0390 and 0393).

Regarding claim 5, **Hellman** further teaches wherein the custom data type elements include one or more elements comprising: a claim custom data type element; a claim payment custom data type element; a class attribute custom data type element; a class attribute value custom data type element; a class custom data custom data type element; a contact-of custom data type element; a contract custom data type element; a cost list custom data type element; and a cost list line custom data type element (¶¶s 0390 and 0393).

Regarding claim 6, **Hellman** further teaches wherein the custom data type elements include one or more elements comprising: a credit bureau report custom data type element; a customer-of custom data type element; an employee-of custom data type element; an expense custom data type element; an expense line custom data type element; a financial account custom data type element; a financial applicant custom data type element; a financial application account custom data type element; a financial application collateral custom data type element; a financial application custom data type element; a financial application funding source custom data type element; and a financial statement custom data type element (¶¶s 0390 and 0393).

Regarding claim 7, **Hellman** further teaches wherein the custom data type elements include one or more elements comprising: a forecast custom data type element; a forecast line detail custom data type element; a product catalog custom data type element; a product catalog line item custom data type element; a product custom

Art Unit: 2167

data type element; a product inventory location custom data type element; a product line custom data type element; a product price custom data type element; an installed product custom data type element; a price list custom data type element; and a price list line custom data type element (§§s 0390 and 0393).

Regarding claim 8, **Hellman** further teaches wherein the custom data type elements include one or more elements comprising: a purchase order custom data type element; a purchase order line item custom data type element; a vehicle anti theft device custom data type element; a vehicle custom data type element; a vehicle option custom data type element; a person custom data type element; a policy custom data type element; a position custom data type element; a related-to custom data type element; a represented-by custom data type element; a security custom data type element; a service request custom data type element; and a set of books custom data type element (Appendix A, page 29, §§s 0390 and 0412).

Regarding claim 9, **Hellman** further teaches wherein the custom data type elements include one or more elements comprising: an order custom data type element; an order line custom data type element; an order type custom data type element; an organization custom data type element; a party authentication custom data type element; a party custom data type element; a payment custom data type element; a payment line custom data type element; a payment method custom data type element;

Art Unit: 2167

a payment term custom data type element; and a payment type custom data type element (§s 0390 and 0393).

Regarding claim 10, **Hellman** further teaches wherein the custom data type elements include one or more elements comprising: an opportunity custom data type element; an opportunity notes custom data type element; an opportunity revenue item custom data type element; an invoice custom data type element; an invoice line custom data type element; an invoice plan custom data type element; an invoice type custom data type element; a life policy custom data type element; and a list of relationship custom data type element (§s 0390 and 0393).

Regarding claim 11, **Hellman** further teaches wherein the custom data type elements include one or more elements comprising: an inventory balance custom data type element; an inventory balance list of balance balance custom data type element; an inventory transaction custom data type element; an inventory location custom data type element; a functional area custom data type element; a holding custom data type element; and a household custom data type element (§s 0390 and 0393).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

Art Unit: 2167

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 13-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Hellman et al.** ("Hellman") (US 20030163597A1).

Regarding claims 13-20, they may include limitations not covered in the prior art; however, these elements are data structures per se, the data and software structures are considered to be non functional data and are considered to be directed to data Per Se. Thus, the difference is limited to non-functional descriptive material stored on a machine which cannot render an invention non-obvious for an invention that would otherwise have been obvious (see MPEP 2106 IV B 1 (b) and 2126 VI). The fact that the data can be recalled does not make it functional.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Robertson et al. (US 20020188538 A1)

Kahn et al. (US 20020184148 A1)

Chandra et al. (US 20020138582 A1)

Carroll, Thomas J. JR. (US 20020085020 A1)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leslie Wong whose telephone number is (571) 272-4120. The examiner can normally be reached on Monday to Friday 9:30am - 6:30 pm.

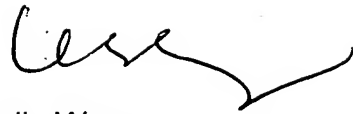
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 10/809,191

Page 12

Art Unit: 2167

A handwritten signature in black ink, appearing to read 'Leslie Wong', with a long horizontal stroke extending to the right.

Leslie Wong
Patent Examiner
Art Unit 2167

LW

December 23, 2004